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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,319	03/06/2002	Tejaswini Hosali	YOR920010754US1	9034

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EXAMINER

WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 11/03/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/092,319
Filing Date: March 06, 2002
Appellant(s): HOSALI ET AL.

Samuel Kassatly
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/1/06.

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(1) *Real Party in Interest*

Examiner agrees with the statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Examiner agrees with the statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

Examiner agrees with the statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

Examiner agrees with the appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of Claimed Subject matter*

Examiner agrees with the summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

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The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,884,246	Boucher et al.	03-1999
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(9) Grounds of Rejection

Claim Rejections - 35 USC 102

1. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Boucher et al. with Patent Number 5,884,246.

1. Regarding claim(s) 1, 18, Boucher teaches translating emails, col. 3, lines 28-38 and "the translation machine identifies the language of the message to be translated",

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col. 11, lines 44-46. Boucher teaches parsing a document to retrieve variable data related to a destination language, col. 11, lines 44-46 such a line items including a destination address as determining "the language into which the message is to be translated by noting the top level domain", col. 11-12, lines 66-2 and "the translation machine determines the country which is the destination of the translated message by the two letter country indicating top level domain", col. 12, lines 10-12. The translation machine parses the destination address to determine the "two letter country". Boucher teaches automatically determining if the parsed variable data[subdomain], including the destination address, requires a dynamic task to be selected, col. 10, lines 3-5 and at col. 11, lines 48-51. Boucher teaches based on the parsed data selecting a destination language for the email and attachments, col. 11, lines 60-62; col. 9, line 45. Boucher teaches sending the email in the destination language with said variable data, col. 9, lines 31-34 and inherently if translation is not required then transmitting the email in the origin language.

2. Regarding claim(s) 2, 10, 19, Boucher teaches sending emails to two addresses in two different languages col. 13, lines 5-12, and the variable data of at least two destination addresses, col. 13, lines 19-24 wherein the different languages are determined as taught above, col. 12, lines 10-14.

3. Regarding claim(s) 3-4, 20-21, Boucher teaches verifying the language based on destination country, col. 12, lines 10-14; col. 9, line 42.

4. Regarding claim(s) 5, 15, 22, Boucher teaches verifying the language based on the communication language exchanged, col. 13, lines 47-49.

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5. Regarding claim(s) 6, 23, Boucher teaches verifying the language based on the preferred destination address's language, col. 13, lines 3-5.
6. Regarding claim(s) 7, 9, 24, 26, Boucher teaches selecting an English language based default, col. 12, lines 2-3.
7. Regarding claim(s) 8, 25, Boucher teaches verifying the language based on destination country, col. 12, lines 10-14.
8. Regarding claim(s) 11, 27, Boucher teaches sending email based on product and services, col. 7, lines 66-67; col. 12, lines 26-30.
9. Regarding claim(s) 12, 28, Boucher teaches an attachment including a document, col. 9, line 44.
10. Regarding claim(s) 13, 29, Boucher teaches an attachment including a document in a distributable format, col. 9, line 45 and since it is being forwarded is being distributed.
11. Regarding claim(s) 14, 30-31, Boucher teaches parsing a document to retrieve variable data triggered by an inquiry, i.e. to translate, col. 10, lines 46-49.
12. Regarding claim(s) 16-17, 32-33, Boucher teaches translating emails, col. 6, line 7 based on Internet addressing, col. 6, line 16.

(10) Response to Argument

The applicants conclude their brief with the argument that Boucher does not use the parsed data of the line items to determine the translation language (Paper Filed

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5/1/06, page 9 lines 15-16). This principal argument is in turn based on two supporting arguments, each of which will be addressed separately.

First, the applicants argue that Boucher does not anticipate the claimed invention because Boucher's translation services could be used in conjunction with the present system, but not to replace the present system (Paper Filed 5/1/06, page 7 lines 22-24). This argument is irrelevant. The issue is not whether Boucher's system could be used in conjunction with the invention as disclosed in the specification. The question is whether Boucher discloses an embodiment that falls within the scope of the claims when given their broadest reasonable interpretation in view of the specification. In this case, Boucher does teach the claimed invention for reasons given below.

Second, the applicants argue that Boucher cannot anticipate the claimed invention because, if a destination language were not specified in Boucher, Boucher would not perform a translation (Paper Filed 5/1/06, page 8, lines 12-14). This argument is also irrelevant. The applicants have drafted their claims using the open-ended transitional phrase "comprising." Accordingly, if Boucher teaches one mode of operation that falls within the scope of the claims, it is irrelevant if Boucher teaches a different mode of operation that does not. In this case, Boucher does teach the claimed invention for the reasons given below.

Since the two supporting arguments are unpersuasive, the principal argument is also unpersuasive.

As to the argument that Boucher does not teach a system that uses the parsed data of the line items to determine the translation language (Paper Filed 5/1/06, page 9

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lines 15-16), the examiner notes that Boucher does teach this limitation. Boucher teaches that "the translation machine identifies the language of the message to be translated (col. 11 lines 44-46). More specifically, Boucher teaches parsing to determine "the language into which the message is to be translated" (col. 11 lines 63-65). Thus, the applicants' argument that Boucher fails to teach the invention as claimed is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

(11) Evidence appendix and Relate proceedings appendix

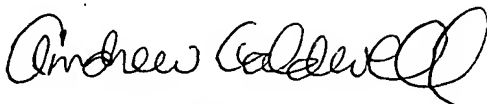
The record is clear there is no evidence submitted and no related proceedings, thus it is assumed that the appellant meant to include both appendixes with the statement "NONE".

Respectfully submitted,


Stephan Willett, Patent Examiner

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10/30/2006


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